

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DON A. HOLLINGSWORTH AND
GREGORY A. HOLLINGSWORTH

Appeal No. 96-2862
Application 08/030,704¹

ON BRIEF

Before MEISTER, ABRAMS, and McQUADE, **Administrative Patent Judges.**

MEISTER, **Administrative Patent Judge.**

¹ Application for patent filed March 12, 1993.

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Application No. 08/030,704

DECISION ON APPEAL

This an appeal from the final rejection of claims 7, 9-13 and 21-24. Claims 14-16 and 20 stand allowed. We affirm-in-part and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), enter new rejections of claim 22 under 35 U.S.C. §§ 102(b) and 103.

The appellants' invention pertains to a tool holder that is adapted to be mounted on a perforated panel. Independent claim 22 is further illustrative of the appealed subject matter and reads as follows:

22. A toolholder, mountable to the front surface of a standard perfboard having front and rear surfaces and having spaced holes therein, said toolholder comprising first and second portions for fitting into two adjacent holes from the front surface, both of said first and second portions comprising means for applying positive pressure against the rear surface around the hole into which it is inserted.

The references relied on by the examiner are:

| | | |
|-----------|--------------|---------------|
| Schuplin | 3,417,438 | Dec. 24, 1968 |
| Muirhead | 4,405,108 | Sep. 20, 1983 |
| Hutchison | Des. 300,003 | Feb. 28, 1989 |

An additional reference relied on by this merits panel of the Board is:

| | | |
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| Niemi | 4,828,209 | May 9, 1989 ² |
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² This reference was made of record by the examiner in the first Office action (Paper No. 4).

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Claim 22 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Muirhead.

Claims 7, 9-13, 21 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hutchison in view of Schuplin.

Claim 24 stands rejected under 35 U.S.C. § 103 as being unpatentable over Hutchison in view of Schuplin and Muirhead.

The examiner's rejections are explained on pages 3-6 of the answer. The arguments of the appellants and the examiner in support of their respective positions may be found on pages 5-18 of the brief and pages 7-12 of the answer.

Considering first the rejection of claim 22 under 35 U.S.C. § 102(b) as being anticipated by Muirhead, we find nothing in Muirhead to indicate that the fasteners 32 apply "positive pressure against the rear surface around the hole into which it is inserted" as this claim expressly requires. Muirhead only expressly teaches that the split portions of the fasteners 32 flex inwardly as the end of the fasteners pass through a hole and thereafter that:

the portions flex outwardly providing an interference holding relationship with the head abutting the rear surface of the mounting board for secure retention of holder **15**. [See column 3, lines 55-58].

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It does not follow that just because the head "abuts" the rear surface, that it also applies positive pressure (e.g., the head might only barely touch the rear surface).

Recognizing this obvious deficiency, the examiner has also taken the position that:

When a tool is supported on the holder as shown at "S" in figure 1, a force is created on the base member (17) having a horizontal component acting pulling [sic] out on the upper fastener (32). Such a force would result in a positive pressure force of the shoulder against the rear surface of the base member. [Answer, page 7.]

However, we must point out that, in such an instance, it is the user which applies the positive force by a pulling action. On the other hand, claim 22 expressly requires that it is the first and second **portions** which comprise the means for applying the positive force.

Since each and every feature set forth in claim 22 is not taught by Muirhead, either expressly or under the principles of inherency, we will not sustain the rejection of this claim under 35 U.S.C. § 102(b).

Turning to the rejection of claims 9 and 21 under 35 U.S.C. § 103 as being unpatentable over Hutchison in view of Schuplin, the brief states that:

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Hutchison is devoid of Appellants' claimed "second portion" which is passable through the hole in the perfboard. There is no indication that the split project of Hutchison passes through the board.

Schuplin shows and describes a separate fastener which is not intended to be, or suggested to be, integrally formed with any other member. In the claimed invention, the second portion is "integrally formed with said base member and said first portion". [Page 9.]

These contentions are not persuasive.

As to appellants' contention that there is no indication that the split projection of Hutchison passes through the pegboard, Hutchison is a design patent and, hence, obviously has no written description. However, it is well settled that in evaluating references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Moreover, artisans must be presumed to know something about the art apart from what the references disclose (*In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (*In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Viewing Fig. 2 of Hutchison, we are of the opinion

that one of ordinary skill in this art would understand as a matter of common knowledge and common sense that, in order for Hutchison's device to function in its intended manner as a "DISPLAY HOOK FOR PEGBOARD" as set forth in the title, the split projections would indeed pass through the holes in the pegboard.

As to the appellants' contention that Schuplin merely discloses a separate fastener which is not intended to be formed with any other member, we point out that in the embodiment of Figs. 10-13, Schuplin clearly shows his fasteners being integrally formed with a strap-type holder 52.

It is also the appellants' contention that there is no suggestion to combine the teachings of Hutchison and Schuplin in the manner proposed by the examiner. This, according to the appellants, is especially the case because:

Hutchison's article of design is a passive device. There is no indication of a need for a Schuplin-type device in Hutchison. Since the weight of an object on the arm of the Hutchison device will aid in forcing the lower fastener more firmly against the perfbboard, there would be no incentive to look elsewhere to replace Hutchison's lower fastener with something else, let alone to look to a field of art in which the main concentration of function is to connect one object to another (a cable strap 46 or 52 in Schuplin, for example). [Brief, page 17.]

We cannot agree. While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce

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the claimed device (**see ACS Hospital Sys., Inc. v. Montefiore Hospital**, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)), it not necessary that the cited references or prior art specifically suggest making the combination (**B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.**, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) and **In re Nilssen**, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). Rather the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. **In re Young**, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and **In re Keller**, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Here, Schuplin in column 1, lines 50-61, among the objects of the invention states that it is desired to provide a fastener that (1) is "of a simple, yet rugged, economic construction and which may be quickly and easily assembled and disassembled with a minimum of time and effort" and (2) which "provides optimum pull-out resistance in the mounted secured position thereof." In our view, one of ordinary skill in this art would have found it obvious to substitute in Hutchison for his split projection-type fastener, the fastener 58, 60 disclosed by Schuplin in order to

achieve these expressly stated advantages. As to the appellants' contention that, since the weight of an object on the arm of Hutchison would aid in more firmly forcing the lower fastener against the pegboard, there would be no incentive to replace Hutchison's lower fastener, we note that the artisan would understand as a matter of common knowledge and common sense that "pull-out" forces are often exerted when an object is being removed from a hook-like arm such as that of Hutchison. Thus, there would indeed be incentive for the artisan to replace Hutchison's lower fastener with one which provides optimum pull-out resistance as taught by Schuplin.

The appellants have not separately argued the patentability of dependent claim 21. Accordingly, this claim falls with independent claim 9. 37 CFR § 1.192(c)(7).

In an apparent attempt to provide evidence of nonobviousness the appellants under the heading "SUMMARY OF THE INVENTION" on pages 1 and 2 of the brief have made reference to a magazine article which broadly states that many hooks designed for pegboard have a tenancy to fall off, but that "Power Peg" hooks are "more likely to stay in place" and "Forever Peg Hooks" "absolutely never fall off (barring major abuse, of course)."

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Apparently, the appellants believe that this magazine article establishes long-felt need.

In general, to establish long-felt need, evidence must be presented which demonstrates the existence of a problem which was of concern in the industry and has remained unsolved over a long period of time. **See *Vandenberg v. Dairy Equip. Co.***, 740 F.2d 1560, 1567, 224 USPQ 195, 199 (Fed. Cir. 1984). This can be accomplished, for example, by the testimony of experts in the industry, or publications or the like, which speak to the duration and extent of the problem, and of the substantial effort and resources which had been expended during that time in attempts to solve the problem. **See *Railroad Dynamics, Inc. v. Stucki Co.*** 579 F. Supp. 353, 362, 218 USPQ 618, 628 (E.D. Pa. 1983), ***aff'd***, 727 F.2d 1506, 220 USPQ 929 (Fed. Cir.), ***cert. denied***, 469 U.S. 871 (1984). Once the long-felt need has been established, it must further be shown that the invention satisfied that need. **See *In re Cavanagh***, 436 F.2d 491, 496, 168 USPQ 466, 471 (CCPA 1971). This can be demonstrated, for example, by evidence establishing commercial success and that the industry purchased the claimed invention because it satisfied the long-felt need. **See *W. L. Gore & Assocs., Inc. v. Garlock, Inc.***,

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721 F.2d 1540, 1555, 220 USPQ 303, 315 (Fed. Cir. 1983), **cert. denied**, 105 S. Ct. 172 (1984). When viewed in this context, we are satisfied that the above-noted magazine article falls far short of establishing long-felt need.

In view of the foregoing we will sustain the rejection of claims 9 and 21 under 35 U.S.C. § 103 based on the combined teachings of Hutchison and Schuplin.

Considering now the rejections under 35 U.S.C. § 103 of claims 7, 10-13 and 23 as being unpatentable over Hutchison in view of Schuplin and claim 24 as being unpatentable over Hutchison in view of Schuplin and Muirhead, each of these rejections is based on the examiner's view that the members 20, 22 of Schuplin can be considered to correspond to the "plurality of spaced elongated fingers with thickened tips" as set forth in claim 10 and has cited a dictionary definition of "tip" in support thereof. We must point out, however, that the indiscriminate reliance on definitions found in dictionaries can often produce absurd results. **See In re Salem**, 553 F.2d 676, 682, 193 USPQ 513, 518 (CCPA 1977). More importantly, terms in a claim should be interpreted in a manner consistent with the specification and construed as those skilled in the art would construe them (**see In re Bond**, 910 F.2d 831, 833, 15 USPQ2d 1566,

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1567 (Fed. Cir. 1990), ***Specialty Composites v. Cabot Corp.***, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and ***In re Sneed***, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)). Here, the members 20, 22 which the examiner has identified as corresponding to the claimed plurality of spaced fingers having thickened tips are merely portions of a ***single, loop-like body 6***. The examiner recognizes this but, nevertheless, takes the position that these portions can be considered to be separate fingers connected by a U-shaped portion. In our view the examiner is attempting to expand the meaning of this claimed terminology beyond all reason. Consistent with the appellants' specification, we can think of no circumstances under which one of ordinary skill in this art would interpret the ***single, loop-like body 6*** of Schuplin to comprise a plurality of spaced fingers having thickened tips as the examiner asserts. This being the case, we will not sustain the rejections under 35 U.S.C. § 103 of claims 7, 10-13 and 23 based on the combined teachings of Hutchison and Schuplin and of claim 24 based on the combined teachings of Hutchison, Schuplin and Muirhead.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejections.

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Claim 22 is rejected under 35 U.S.C. § 102(b) as being anticipated by Niemi. Niemi discloses a holder 10 mountable to the front surface of a panel of standard perfboard or pegboard 11 having spaced holes therein comprising first and second portions 32A, 32 fitting into two adjacent holes, both of the first and second portions comprising means 38 in conjunction with portions of fingers 32 for applying positive pressure against the rear surface around the hole into which it is inserted. As to the limitation in the preamble that the holder is a "tool holder," the particular manner in which a device or article is used cannot be relied on to distinguish structure from the prior art. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), *In re Yanush*, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973) and *In re Casey*, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). Here, the holder of Niemi clearly has the **capability** of holding a tool and whether a tool actually is or might be placed in Niemi's holder depends upon the performance or non-performance of a future act of use, rather than upon a structural distinction in the claims. Stated differently, the holder of Niemi would not undergo a metamorphosis to a new holder simply because a tool was placed in

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it. ***See In re Pearson***, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and ***Ex parte Masham***, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

Claim 22 is rejected under 35 U.S.C. § 103 as being unpatentable over Muirhead in view of either Schuplin or Niemi. As we have noted above, Schuplin discloses fasteners 58, 60 that are integrally formed with a holder 52, which fasteners provide "optimum pull-out resistance" (see column 1, line 60) when attaching the holder to a perforated panel. Niemi discloses fasteners 32 that are integrally formed with a holder 10, which fasteners lock the holder in place on perfboard or pegboard panel (see column 1, lines 46-56). One of ordinary skill in this art would have found it obvious to substitute in Muirhead for his fasteners 32 the fasteners of either Schuplin or Niemi in order to achieve the expressly stated advantage of providing "optimum pull-out resistance" as taught Schuplin or "locking" the holder to the perfboard or pegboard panel as taught by Niemi.

In summary:

The rejection of claim 22 under 35 U.S.C. § 102(b) is reversed.

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The rejection of claims 9 and 21 under 35 U.S.C. § 103 is affirmed.

The rejections of claims 7, 10-13, 23 and 24 under 35 U.S.C. § 103 are reversed.

New rejections of claim 22 under 35 U.S.C. §§ 102(b) and 103 have been made.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of

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rejection to avoid termination of proceedings (37 CFR § 1.197(c))
as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART
37 CFR § 1.196(b)

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| JAMES M. MEISTER |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| NEAL E. ABRAMS |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
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